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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/371,212	08/10/1999	RONALD A. KATZ	245/099	8956

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EXAMINER

WOO, STELLA L

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/371,212	Applicant(s) KATZ, RONALD A.	
	Examiner Stella L. Woo	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-111 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-111 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/28/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 51-106 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Independent claim 51 recites “qualifying the buyer for consummating the transaction at least in part based on the check digit that includes a sum check of at least a portion of the digits.” However, applicant’s specification does not describe such a qualifying step. The specification is directed to a system which controls and regulates communications between buyers and vendors, allowing negotiation with regard to goods and services. The system does not handle the consummation of a transaction. On page 7, lines 8-14 and page 32, line 30 through page 33, line 24, the specification describes *qualifying callers for access to the system* so that only authorized persons can make appointments, solicit proposals, respond to a proposal, or make a special offering. It does not describe *qualifying callers for consummating the transaction*.

Independent claim 80 recites “an interested vendor site receiving the buyer request responds, as to consummate a transaction.” However, applicant’s specification does not describe a vendor responding to consummate a transaction. Rather, it describes a vendor responding to a buyer request by seeking an appointment (page 12, line 26 – page 13, line 10) or making a proposal (page 33, lines 25-27).

3. Claims 108-109 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 108 recites “One or more central control units...comprising the steps of: at least one buyer...” It is not clear as to whether claim 108 is reciting a method or an apparatus.

Claim 109 recites “A traffic control system...comprising:...transmitting an electronic mail message...” The transmitting step is inconsistent with the claim format of system claim 109.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 51-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al. (US 5,727,164, hereinafter "Shavit") in view of Kaye et al. (US 5,727,164, hereinafter "Kaye"), and further in view of Foster et al. (US 4,897,867, hereinafter "Foster").

Shavit discloses a method of telephonically using a traffic control system (interactive market management system) for communication involving a buyer terminal (buyer 62) and at least one vendor terminal (distributors 83 or suppliers 84) for consummating sales transactions (processing business transactions; Abstract), the method including the steps of:

establishing telephonic communication from a buyer terminal to receive a buyer request (a buyer can submit a request for quotation (RFQ) over the public telephone system; col. 11, lines 39-51; col. 12, line 54 - col. 13, line 10);

indicating a transaction (the RFQ includes the goods or services desired by the buyer; col. 12, line 63 - col. 13, line 9);

establishing telephonic communication with at least one vendor terminal to transmit the buyer request (the RFQ data is transmitted to a distributor for authorization, resulting in a bid released to the buyer for conversion to a purchase order; col. 13, lines 29-34; col. 13, line 54 - col. 14, line 9); and

making a record regarding transactions for billing purposes (orders are recorded for payment processing; col. 8, line 55 - col. 9, line 42; col. 14, lines 33-62); and

providing an electronic mail message (system 50 provides email messages to each user, including bids in response to requests for particular goods or services input by the user, promotions, and other information of particular interest to buyers; col. 11, lines 52 – col. 12, line 26; col. 13, lines 25-27; col. 18, lines 44-49; col. 20, lines 2-39).

Shavit differs from claims 51-79 in that it does not specify the buyer request as including a specified purchase price. However, Kaye teaches the desirability of allowing a buyer to specify a maximum purchase price as part of the desired product information (col. 4, lines 11-20; col. 5, line 53 - col. 6, line 2) in order to locate a vendor willing to sell the desired product at a minimum cost. Since Shavit is similarly directed to providing buyers with access to multiple vendors, it would have been obvious to an artisan of ordinary skill to allow a buyer to include a desired purchase price as part of the buyer request, as taught by Kaye, within the request for quotation of Shavit in order to locate a vendor willing to sell the desired product at minimum cost.

The combination of Shavit and Kaye differs from claims 51-79 in that it does not specify utilizing data which includes a check digit and qualifying the buyer at least in part based on the check digit. However, the Shavit system does require a buyer to enter an authorized user ID and password prior to receiving access to the system (col. 11, lines 39-47), and Foster teaches the well known use of a check sum digit for verifying an entered number (col. 7, lines 54-65) such that it would have been obvious to an artisan of ordinary

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skill to use a check sum digit, as taught by Foster, within the combination of Shavit and Kaye in order to verify the number of digits entered by the user as being the expected number of PIN digits.

6. Claims 80-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Shavit and Kaye, and further in view of Smith (US 5,450,123).

Shavit discloses a method of telephonically using a traffic control system (interactive market management system) for communication involving a buyer terminal (buyer 62) and at least one vendor terminal (distributors 83 or suppliers 84) for consummating sales transactions (processing business transactions; Abstract), the method including the steps of:

establishing electronic communication from a buyer terminal to receive a buyer request (a buyer can submit a request for quotation (RFQ) over the public telephone system; col. 11, lines 39-51; col. 12, line 54 - col. 13, line 10) indicating a transaction (the RFQ includes the goods or services desired by the buyer; col. 12, line 63 - col. 13, line 9);

establishing electronic communication with at least one vendor terminal to transmit the buyer request (the RFQ data is transmitted to a distributor for authorization, resulting in a bid released to the buyer for conversion to a purchase order; col. 13, lines 29-34; col. 13, line 54 - col. 14, line 9); and

making a record regarding transactions for billing purposes (orders are recorded for payment processing; col. 8, line 55 - col. 9, line 42; col. 14, lines 33-62); and

providing an electronic mail message (system 50 provides email messages to each user, including bids in response to requests for particular goods or services input by the user, promotions, and other information of particular interest to buyers; col. 11, lines 52 – col. 12, line 26; col. 13, lines 25-27; col. 18, lines 44-49; col. 20, lines 2-39).

Shavit differs from claims 80-106 in that it does not specify the buyer request as including a specified purchase price. However, Kaye teaches the desirability of allowing a buyer to specify a maximum purchase price as part of the desired product information (col. 4, lines 11-20; col. 5, line 53 - col. 6, line 2) in order to locate a vendor willing to sell the desired product at a minimum cost. Since Shavit is similarly directed to providing buyers with access to multiple vendors, it would have been obvious to an artisan of ordinary skill to allow a buyer to include a desired purchase price as part of the buyer request, as taught by Kaye, within the request for quotation of Shavit in order to locate a vendor willing to sell the desired product at minimum cost.

The combination of Shavit and Kaye differs from claims 80-106 in that although it provides for allowing subscriber access to a variety of data base services (col. 5, lines 58-65; col. 7, lines 6-46), it does not specify communication video. However, Smith teaches the desirability of allowing

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buyer access to a vendor supplied video image stored in a video file server (video source and database 6) for enhancing sales communication with the use of video (col. 1, line 51 - col. 3, line 27) as well as including a camera at the agent's terminal so that direct, real-time, point-to-point video communication can take place between a customer and the representative (col. 3, lines 26-27; col. 4, lines 25-28; moving pictures are communicated via AT&T 2500 video telephone sets, col. 1, lines 27-28) such that it would have been obvious to an artisan of ordinary skill to incorporate such use of dynamic, full-motion video, as taught by Smith, within the method of Shavit in order to allow a buyer to view the desired goods or services as well as real-time video communication between the customer and representative. Smith provides for prompts to view an available video (col. 2, lines 53-56; col. 4, lines 45-50) and providing client specific video (col. 5, lines 48+).

The examiner further takes Official Notice that it is old and well known in the art at the time of invention to provide for freeze-frame and high resolution video capability in a video communication system such that it would have been obvious to an artisan of ordinary skill to incorporate such well known video features within the combination of Shavit, Kaye, and Smith in order to allow for a higher quality video reception.

7. Claims 107-110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit in view of Dworkin (US 4,992,940), and further in view of Smith (US 5,450,123).

Shavit discloses a method for enabling communications, comprising the steps of:

establishing an interface (a buyer can submit a request for quotation (RFQ) over the public telephone system; col. 11, lines 39-51; col. 12, line 54 - col. 13, line 10);

receiving and storing data (the RFQ includes the goods or services desired by the buyer; col. 12, line 63 - col. 13, line 9);

selecting the responding vendor site (the RFQ data is transmitted to a distributor for authorization, resulting in a bid released to the buyer for conversion to a purchase order; col. 13, lines 29-34; col. 13, line 54 - col. 14, line 9); and

providing an electronic mail message (system 50 provides email messages to each user, including bids in response to requests for particular goods or services input by the user, promotions, and other information of particular interest to buyers; col. 11, lines 52 - col. 12, line 26; col. 13, lines 25-27; col. 18, lines 44-49; col. 20, lines 2-39).

Shavit differs from claims 107-110 in that it does not specify the central unit selecting a vendor based on the area of interest. However, Dworkin teaches the desirability of displaying all vendors who can supply a particular product (col. 6, lines 26-37; col. 7, lines 12-14) such that it would have been obvious to an artisan of ordinary skill to incorporate such vendor selection, as taught by Dworkin, within the method of Shavit so that buyer requests are

submitted only to select vendors who can supply the particular goods or services desired by the buyer.

The combination of Shavit and Dworkin differs from claims 107-110 in that although Dworkin provides text information regarding merchandise, it does not specify presenting video data. However, Smith teaches the desirability of allowing buyer access to a vendor supplied video image stored in a video file server (video source and database 6) for enhancing sales communication with the use of video (col. 1, line 51 - col. 3, line 27) such that it would have been obvious to an artisan of ordinary skill to incorporate such use of video, as taught by Smith, within the combination of Shavit and Dworkin in order to allow a buyer to view an image of the desired goods or services.

8. Claim 111 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin (US 4,992,940) in view of Smith.

Dworkin discloses a system for consummating merchandising transactions comprising:

means for causing a vendor to be identified (list of suppliers associated with a desired product can be viewed for selection; Fig. 2B, step 53, 55, 57);

means for effecting presentation of merchandise items (products are displayed; Figure 2A, step 40);

an item database (database 3 in Figure 1; col. 3, lines 63-68);

means for receiving information including cost (product data including price is received from database 3; col. 6, lines 26-35),.

a buyer information database (system can store information about each user; col. 8, lines 20-24);

a control means (CPU 1; Figures 1, 2A, 2B) which allows the buyer to order a selected product (col. 8, lines 3-56) by means of a display (terminal 5 displays menus, product information, vendor information, etc.; Figure 2A, steps 23, 29, 40; Figure 2B, steps 51, 55, 69; Figures 3-8) and including communication by at least one electronic mail message (orders to suppliers can be placed by electronic mail; col. 4, lines 19-22; col. 8, lines 32-35).

Although Dworkin provides text information regarding merchandise, it does not specify presenting video data. However, Smith teaches the desirability of allowing buyer access to a vendor supplied video image stored in a video file server (video source and database 6) for enhancing sales communication with the use of video (col. 1, line 51 - col. 3, line 27) such that it would have been obvious to an artisan of ordinary skill to incorporate such use of video, as taught by Smith, within the system of Shavit in order to allow a buyer to view an image of the desired goods or services.

Response to Arguments

9. Applicant's arguments filed April 26, 2006 have been fully considered but they are not persuasive.

Regarding the rejection of claims 51-106 under 35 USC 112, first paragraph, Applicant argues that his system accomplishes the operation of "consummating a transaction" and points to page 5 of the specification.

However, page 5 merely describes the system as recognizing the need between members of plural groups to consummate transactions. It does not describe the step of “qualifying the buyer for consummating the transaction...” as recited in claim 51. The specification describes qualifying callers for access to the system in order to make appointment, solicit proposals, respond to a proposal, or make a special offering (page 7, lines 8-14; page 32, line 30 – page 33, line 24), not to consummate a transaction.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

10. Applicant's arguments with respect to claim 111 have been considered but are moot in view of the new ground of rejection.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply

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is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number is (571) 272-7512. The examiner can normally be reached on Monday-Friday, 8:00 a.m. to 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Stella L. Woo', with a stylized, flowing script.

Stella L. Woo
Primary Examiner
Art Unit 2614